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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,226	07/02/2001	Kevin P. McAuliffe	6169-206	9030

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/897,226

Applicant(s)

MCAULIFFE ET AL.

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 2/20/2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 9, 10, 19, 20, 35, 36, 45, and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

Regarding claims 9, 10, 19, 20, 35, 36, 45, and 46, the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how applicant intends to bias a straight comparison in favor on one party over the other.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 9, 10, 19, 20, 35, 36, 45, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 9, 10, 19, 20, 35, 36, 45, and 46, these claims recite the limitation "said comparing step is biased in favor of". It is unclear how a straight comparison may be biased in favor of a merchant or a consumer. Examiner argues that a comparison is inherently in favor of the participant who finds the results of the comparison the most useful.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-20 and 23-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber (U.S. Patent No. 5,794,210).** Goldhaber teaches a system and method for e-commerce transaction negotiation that includes all of the limitations recited in the above claims.

Regarding claims 1, 11, 23-25, 27, and 37, Goldhaber teaches CPRs (software agent equipped with a consumer interest profile and specific buy/sell instructions) (Column 16, Lines 24-29 and Column 19, Lines 28-31), MBOs (Salesmen or bidding agents that have incentive or pricing information) (Column 4, Lines 58-59 and Column 19, Lines 31-33), exchange of consumer information (upon viewing the advertisement, the consumer answers questions) (Column 16, Lines 10-15), and comparison to determine if an agreement can be made (once an advertisement is found to present to

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the consumer, the consumer views the advertisement and presents consumer information for payment) (Column 16, Lines 24-29). The selected good is considered to be the consumer's information commodity associated with bidding/asking price. There is no step of the negotiation engine actually consummating the transaction itself. Therefore, the user clicking on the CyberCoin in Goldhaber does not teach away from this feature. Consumer software agents have specific buy and sell instructions issued by the consumer, and this reads on consumer-specified rules specifying minimum cash and cash-equivalents.

Regarding claims 2, 12, 28, and 38, Goldhaber teaches providing e-commerce transaction information to a processing system (Column 16, Lines 13-15).

Regarding claims 3-6, 13-16, 29-32, and 39-42, Goldhaber teaches the adjusting of pricing structures by bidding for consumer attention (Column 4, Lines 52-62). Counter offers are taught by attention bidding. Further, Goldhaber teaches buyer and seller agents as negotiating transactions (Column 8, Lines 26-28) and agent aided negotiation and bidding (Column 20, Line 51). Counter offers are inherent in negotiation situations.

Regarding claims 7, 8, 17, 18, 26, 33, 34, 43, and 44, Goldhaber uses CyberCoin, which is a cash equivalent. Before joining the system, it is inherent that the user will agree (by signing up) to the form of compensation.

Regarding claims 9, 10, 19, 20, 35, 36, 45, and 46, if the buyer in Goldhaber is more pleased with the results of a comparison than a seller, then there is considered to be a bias towards the buyer and vice versa.

Response to Arguments

4. **In response to the 112 rejections**, Applicant points to specific portions of the specification on pages 4 and 16. In these portions, it simply states that the party installing the software may bias the system in favor of the consumer or the merchant. This is essentially what the claims state. However, it is unclear how a bias may be set in this comparison. The system takes merchant criteria and customer criteria, holds them to be compatible with each other or incompatible, and returns that determination. In a simplistic example, the merchant may create a rule stating "I want to sell X for \$30" and consumer A may create a rule stating "I want to buy X for \$10" while consumer B creates a rule stating "I want to buy X for \$30". When the comparison takes place, a determination is returned that an agreement could be reached with consumer B and not necessarily with consumer A. Examiner fails to understand how a comparison may be biased, and while the specification recites that a bias may take place, it lacks an enabling description as to how the system is able to bias a straight comparison. Thus, this rejection is maintained.

5. **In response to the 102 rejection**, applicant has amended the claims to specify what the MBOs and CPRs specify, along with adding a little depth to the step of negotiating. These amendments, while they seemingly narrow the invention, do not overcome the prior art for the following reasons:

- Applicant has amended the MBOs to recite a plurality of cash or cash-equivalent incentives offered to a consumer. This feature is recited in

Goldhaber in the form of automatic bidding agents, which may be found at Column 4, Lines 58-60. Since this process is automatic, and the agents are placing bids, this inherently reads on merchant-specified rules (programmed in advance) specifying cash or cash-equivalents.

- Applicant has amended the CPRs to recite a minimum cash or cash-equivalent incentive for which a consumer will exchange specific items. This feature is recited in Goldhaber in the form of software agents, which may be found at Column 19, Lines 28-33. These software agents have specific buy and sell instructions issued by the consumer, and this reads on consumer-specified rules specifying minimum cash and cash-equivalents.
- Applicant has amended the step of comparing MBOs and CPRs to include a negotiation engine that determines if an agreement may be reached without interaction from a merchant or consumer. Goldhaber teaches this at Column 16, Lines 24-31. If advertisements are returned, then it was determined that an agreement could be reached (regardless of if an agreement is actually reached or not). There is no step of the negotiation engine actually consummating the transaction itself. Therefore, the user clicking on the CyberCoin in Goldhaber does not teach away from this feature. In fact, an argument could be made that even if Applicant's claims did recite automatic consummation by the negotiation engine, it would be obvious to perform such a step in the interest of making the

entire process more hands off and easier for both the merchant and the consumer.

Therefore, the 102(b) rejections over Goldhaber appear to remain appropriate.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER